

REMARKS

Claims 94, 100, 104, 108 and 109 remain in this application, of which Claims 94, 100 and 104 are in independent form.

In the outstanding Office Action, Claims 94, 100, 104, 108 and 109 were rejected under 35 U.S.C. § 103(a) as being obvious from Applicant Admitted Prior Art (AAPA) in view of U.S. 2001/0005833 (*Asami*), and also as being obvious from the AAPA in view of U.S. Patents 7,678,787 (Walker et al.) and 6,167,382 (Sparks et al.),

Applicants submit herewith sworn translations of Japanese Patent Applications 2000-131747, filed April 28, 2000, and 2001-123002, filed April 20, 2001, which are the priority applications from which the present application claims benefit under 35 U.S.C. § 119. Applicants note that the April 28, 2000, filing date of the earlier of those Japanese patent applications is prior to the December 22, 2000, U.S. filing date of *Asami*, which is the date as of which *Asami* is available as prior art. Applicants submit that their pending claims are fully supported by that priority application, and hence submit that *Asami* is not available as prior art against the present application.

Nonetheless, Applicants also submit that, even if *Asami* were available as prior art against the present application, the independent claims herein would be patentable over that document, taken alone or in combination with AAPA, for at least the following reasons.

Asami relates to a system that allows a participant in an awards program to access a website from which he or she can ascertain the number of points available for use. A participant wanting to sell an article purchased through the program can also use the website to learn the current resale value of the article. The website can also tell the

participant what it will cost to make a new purchase, net of the resale price of such article (if any), and upon application of such points as the participant has and wishes to apply toward the new purchase.

The Examiner apparently considers that, since both the consumables-collection system and the *Asami* system use a website to tell a participant the cost of a new purchase taking into account a credit that is based in some fashion on the participant returning/reselling something that the participant has bought previously, it would have been natural to use the *Asami* website for the collection system. The Examiner concedes that *Asami* does not handle or display any information corresponding to the collection rate, but believes that the exact choice of information to display would be a matter of design choice once it had been decided to use the *Asami* website system in the collection system of Applicants.

Applicants note, however, that *Asami* contemplates providing owners of goods of types that are commonly used for a while and then sold to second-hand dealers, with information about the current resale price, in order to make it easier for such owners to determine the best time to sell. This is not the same as the purchaser of office supplies such as toner cartridges, who will need to purchase more such supplies for the indefinite future, and who wants or is legally required to return certain portions of the exhausted supplies for recycling. This purchaser will wish to know the collection rate.

Applicants therefore submit that even if the AAPA and *Asami* are taken as showing all that they are cited for, one of merely ordinary skill would have had no reason to attempt to combine them in the fashion proposed in the Office Action. Accordingly, it is submitted that the rejection based on *Asami* is based on impermissible hindsight

reconstruction of those documents, and should be withdrawn, even if *Asami* were available as prior art.

With regard to the rejection based on AAPA, *Walker* and *Sparks*, we believe this rejection to be without merit. Most of the analysis in the Office Action underlying this rejection amounts to a simple assertion that *Walker* would have made it obvious to try to automate the conventional process of the AAPA. Even if that assertion is accepted, however, the system that is automated in *Walker* is different from that of the AAPA in a number of important respects.

First, *Walker* is concerned only with incentives to get the registered customer to buy more. There is no concern with getting a customer to return used consumables of any type, nor is there any suggestion in *Walker* that the *Walker* system could be applied to a collection/recycling system. Even if the Examiner's analysis were correct in other respects, Applicants submit that this would be an insuperable deficiency: even if *Walker* were deemed to teach providing a customer with incentives to buy more, there is no hint in that patent of any incentive to recycle more. Still less can there be found any suggestion in *Walker* of the specific feature of the claims that the incentive can only be offered based on plural previous collections of consumables.

Moreover, *Walker* is a POS system, whose output (screen display) is for a sales clerk, not for the customer. (The Examiner recognizes this, judging from the argument at the top of page 10 that it would have been obvious to turn the *Walker* display around so that it could be seen by the customer too, just in case the screen prompts are not enough to get the clerk to offer all the relevant promotions.) Applicants do not see how it

would have been obvious to modify the *Walker* approach to accommodate a system of organizations like that shown in Fig. 1.

Applicants submit that one of ordinary skill would not have been led by *Walker* to attempt to modify the AAPA system at all. Moreover, even granting the attempt, nothing in *Walker* or the AAPA would have led one of ordinary skill to a server, method or software having all the features recited in the present independent claims.

Sparks is cited only for a confirmation screen, and appears to have substantially no relation to either *Walker* or AAPA. Even if the proposed combination were a proper one, however, the confirmation screen would not supply what is missing from the other prior art as references against the present claims.

Accordingly, withdrawal of this rejection also is respectfully requested.

A review of the other art of record has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and allowance of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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